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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,809	11/10/2005	Nicholas Russell	034164.002	6771
441 7590 08/20/2007 SMITH, GAMBRELL & RUSSELL 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			EXAMINER ZAHR, ASHRAF A	
			ART UNIT 2109	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/522,809

Applicant(s)

RUSSELL, NICHOLAS

Examiner

Ashraf Zahr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9-15,19,31,39-41,43,50,62-64,79 and 80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9-15,19,31,39-41,43,50,62-64,79 and 80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/31/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/23/07, 12/16/05, 01/31/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Examiner is examining attached replacement sheets containing the translation of the Article 19 Amendments. Claims 1-80 are pending in this application. Claims 2-8, 16-18, 20-30, 32-38, 42, 44-49, 51-61 and 65-78 were cancelled.
2. The information disclosure statement (IDS) statements dated 05/23/2007, 12/16/2005, and 01/31/2005 have been received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 14, Node 1406. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig 17, Node 1712. Furthermore, Fig 17, Nodes 1702-1710 are attached to incorrect parts in the drawing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**6. Claims 1, 10, 31, 40, 50, 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Slotznick, US 2001/0033298 (Hereinafter, Slotznick).**

**Regarding Claim 1**, Slotznick discloses “a method for instant messaging on a computer system”. (Slotznick, Fig 1, ¶0032).

Slotznick also discloses “receiving an instant message (IM) containing content from a sender” (Slotznick, Fig 1, ¶0033).

Slotznick also discloses “displaying an animated character associated with said sender” (Slotznick, Fig 1, ¶0035).

Slotznick also discloses “delivering said content to a user through said animated character” (Slotznick, Fig 1, ¶0035).

**Regarding Claim 10**, Slotznick also discloses “the method of claim 1, further including: sending an alert to a server” (Slotznick, Fig 1).

Slotznick also discloses, “receiving a response containing content from said server generated by an artificial intelligence (AI) application” (Slotznick, ¶0024).

Slotznick also discloses, “displaying an animated character associated with said AI application” (Slotznick, Fig 1, ¶0035).

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Slotznick also discloses, "delivering said content to a user through said animated character associated with said AI application". (Slotznick, Fig 1, ¶0035).

**Regarding Claim 31**, this claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

**Regarding Claim 40**, this claim is substantially similar to claim 10 and is therefore rejected based upon the same reasoning used to reject claim 10.

**Regarding Claim 50**, applicant is claiming the apparatus used to perform the method in claim 1. This claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

**Regarding Claim 79**, this claims a program storage device readable by a machine" of the method in claim 1. Therefore, this claim is rejected based upon the same reasoning used to reject claim 1.

7. **Claims 19, 43, 64, and 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim, US 6,910,186 (Hereinafter, Kim).**

**Regarding Claim 19**, Kim discloses "a method for managing an Instant Messaging (IM) system" (Kim, Fig 4C).

Kim also discloses "including receiving a request from a user for an animated character". Kim discloses of using contracting with the owner of the image for use of the image (Kim, Fig 4, col 12, ln 9-23).

Kim also discloses "said request including an identification of a sender of an IM message to said user". (Kim, Fig 4C, node 132N, col 12, ln 9-23)

Kim also discloses "querying a database with said identification" (Kim, Fig 4C col 12, ln 9-23).

Kim also discloses "receiving information regarding said animated character from said database" (Kim, Fig 4B, col 12, ln 9-23).

Kim also discloses "forwarding said information regarding said animated character to said user" (Kim, Fig 4B, col 12, ln 9-23).

**Regarding Claim 43**, this claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claim 19.

**Regarding Claim 64**, this claim is the apparatus used to perform the method in claim 19. This claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claims 19.

**Regarding Claim 80**, this claims a program storage device readable by a machine" of the method in claim 19. Therefore, this claim is rejected based upon the same reasoning used to reject claim 19.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 9, 13-15, 39, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298 (Hereinafter, Slotznick) in view of Kim, US 6,910,186 (Hereinafter, Kim).**

**Regarding Claim 9,** Slotznick discloses all the limitations of the “the method of claim 1.

Slotznick does not disclose “periodically retrieving advertisement details from a server”. Kim remedies this with the disclosure of downloading information from a server (Kim, col 12, ln 9-22). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).

Slotznick also does not disclose “downloading an animated character specified to represent said advertisement”. Kim remedies this with the disclosure of downloading an organizational avatar (Kim, col 8, ln 45-65). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim.



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The motivation for doing so is to increase interactivity with customer (Kim col 8, In 62-63).

Slotznick also does not disclose “displaying said animated character specified to represent said advertisement”. Kim remedies this with the disclosure of using the organizational avatar to advertise cost effectively (Kim, col 8, In 45-65). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, In 62-63).

Slotznick also does not disclose “delivering content specified for said advertisement”. Kim remedies this with the disclosure of using the organizational avatar to advertise cost effectively (Kim, col 8, In 45-65). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, In 62-63).

**Regarding Claim 13**, Slotznick does not specifically disclose “the method of claim 1, further including: allowing the user to select from one or more predefined animated characters to be displayed on a recipient's computer system when said user sends an IM message to said recipient”. However, Kim remedies this with the disclosure of having the user enter into a contract with the owner of an organizational avatar (Kim, col 9, In 0-19). It would be obvious to one of

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ordinary skill in the art at the time of the invention to combine the animated characters in Slotznick with the ability to select a predefined character in Kim. The motivation for combining the two references is that the avatar would be used to represent live persons in shared user environment (Kim, col 8, ln 48-50).

**Regarding Claim 14**, Slotznick does not specifically disclose “the method of claim 1, further including: allowing the user to upload an image to be used in creating an animated character to be displayed on a recipient's computer system when said user sends an IM message to said recipient”. However, Kim remedies this with the disclosure of a generic avatar that could be used to represent a user (Kim, col 8, ln 52-54). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the animated characters in Slotznick with the ability to select an artist created generic avatar in Kim. The motivation for combining the two references is that the avatar would be used to represent live persons in shared user environment (Kim, col 8, ln 48-50).

**Regarding Claim 15**, Slotznick discloses “a method for instant messaging on a digital communication system such as a computer system or digital telephone system or combination thereof, including” (Slotznick, Fig 1, ¶0032).

Slotznick also discloses “receiving one or more instant messages (IM) containing content from one or more senders” (Slotznick, Fig 1, ¶0033).

Slotznick also discloses “delivering said content to a user through said animated character” (Slotznick, Fig 1, ¶0035).

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Slotznick does not specifically disclose "forming a queue by creating a dynamic array and inserting incoming message into said queue". Kim remedies this with the disclosure of a buffer to hold data corresponding to related users (Kim, col 12, ln 9-12). It would be obvious to one of ordinary skill in the art at the time of the invention to combine buffer with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Slotznick does not specifically disclose "controlling the timing of operations of actions in the queue and when required displaying an animated character associated with said sender". Kim remedies this by stating the server supplies information to all users that update their respective displays in the normal manner (Kim, col 12, ln 14-19). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the controlling of timing operations to the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

**Regarding Claim 39**, this claim is substantially similar to claim 9 and is therefore rejected based upon the same reasoning used to reject claim 9.

**Regarding Claims 62-63**, applicant is claiming the apparatus used to perform the method in claims 13-14. These claims are substantially similar to claims 13-14 and are therefore rejected based upon the same reasoning used to reject claims 13-14.

**10. Claims 11-12, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298 (Hereinafter, Slotznick) in view of Wolton et al., US 2004/0030741 (Hereinafter, Wolton).**

**Regarding Claim 11**, Slotznick discloses all the limitations of “the method of claim 10”.

However, Slotznick does not disclose “sending a message indicating that a web search is to be performed”. Wolton remedies this with a disclosure of a boolean search (Wolton, Fig 4).

However, Slotznick also does not disclose “sending keywords to search in said web search”. Wolton remedies this with a disclosure of sending search terms (Wolton, ¶0153).

It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

**Regarding Claim 12**, Slotznick also does not disclose “the method of claim 11, wherein said delivering said content comprises delivering results of said web search”. Wolton remedies this with a disclosure of a retrieval system (Wolton, ¶244). It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation

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to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

**Regarding Claim 41**, this claim is substantially similar to claim 11 and is therefore rejected based upon the same reasoning used to reject claim 11.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nishihata, US 2003/0011643, Representation Data Control System, and Representation Data control Device Constituting IT, And Recording Medium Recording Its Program

Takagi et al., US 6,493,001, Method, Apparatus, and Medium For Describing A Virtual Shared Space Using Virtual Reality Modeling Language

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashraf Zahr whose telephone number is (571) 274-1973. The examiner can normally be reached on Mon.-Thurs., 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on (571) 272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAZ

  
FRANTZ COBY  
SUPERVISORY PATENT EXAMINER